

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.: 10/522,696 Confirmation No.: 1883
Applicant(s): Wang, et al.
Filed: January 27, 2005
Art Unit: To be determined
Examiner: To be determined
Title: METHODS AND COMPOSITIONS FOR CONVERTING TAXANE
AMIDES TO PACLITAXEL OR OTHER TAXANES

Docket No.: 048767.287534
Customer No.: 00826

Mail Stop PCT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION UNDER 37 C.F.R §1.47(a) TO ACCEPT DECLARATION WITHOUT
SIGNATURE OF INVENTOR REFUSING TO SIGN DECLARATION IN
RESPONSE TO NOTICE OF MISSING REQUIREMENTS**

Applicant hereby petitions the Commissioner for Patents under 37 C.F.R. §1.47(a) to accept the accompanying Declaration signed by co-inventors Rex T. Gallagher, John S. Juchum, and James H. Johnson without the signature of inventor Dasheng Wang who refuses to join in the above-identified application. It is therefore requested that the application be made by the other inventors on behalf of themselves and the non-signing inventor.

I. Proof of Pertinent Facts

Attached is the Declaration by Cynthia V. Hall, emails from Dasheng Wang and Cynthia V. Hall, and a letter from Cynthia V. Hall to Dasheng Wang dated May 23, 2006 proving the pertinent facts. As shown in the Declaration of Cynthia V. Hall, Dasheng Wang was presented with a copy of the subject patent application and a Declaration on via email on April 26, 2006 and via Express Mail on May 24, 2006. As shown in the email from Dasheng Wang dated May 26, 2006 (Attachment D), Dasheng Wang

indicated that he would not sign the Declaration because he was not listed first on the "WO patent" [WO 2004/013096 A2, the corresponding published international patent application.]

II. Fee

The Commissioner is authorized to charge our Deposit Account No. 16-0605 the fee required under 37 C.F.R. §1.17(g). The Commissioner is also authorized to charge our Deposit Account No. 16-0605 for any fee deficiency in connection with this petition.

III. Last Known Address of Non-Signing Inventor

The last known address of the non-signing inventor is:

Dasheng Wang
6109 Round Tower Lane
Dublin, OH 43017

IV. Conclusion

Applicant hereby petitions and requests that this Petition be granted to accept the attached Declaration pursuant to the provisions of 37 C.F.R. §1.47(a) regarding a non-signing inventor, and that this application be advanced to examination.

If there are any questions regarding this matter, please contact the undersigned at the address indicated below or at direct telephone number 404-881-7764.

Thank you for your attention to this matter.

06/05/2006 ATRAN1 00000151 160605 10522696
02 FC:2453 750.00 DA

Respectfully Submitted,



Cynthia V. Hall
Registration No. 56,544

Customer No. 00826

ALSTON & BIRD LLP

Bank of America Plaza

101 South Tryon Street, Suite 4000

Charlotte, NC 28280-4000

Tel Atlanta Office (404) 881-7000

Fax Atlanta Office (404) 881-7777

"Express Mail" mailing label number EV 836147954 US

Date of Deposit May 30, 2006

I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to: Mail Stop PCT, Attn: DO/US (PTO), Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450



Cynthia V. Hall

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.: 10/522,696 Confirmation No.: 1883
Applicant(s): Wang, et al.
Filed: January 27, 2005
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Title: METHODS AND COMPOSITIONS FOR CONVERTING TAXANE
AMIDES TO PACLITAXEL OR OTHER TAXANES

Docket No.: 048767/287534
Customer No.: 00826

Mail Stop PCT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

DECLARATION OF CYNTHIA V. HALL

I, Cynthia V. Hall, do hereby declare and state as follows.

1.

I am an Attorney with Alston & Bird LLP in Atlanta, Georgia, and registered to practice before the United States Patent and Trademark Office. Alston & Bird LLP represents Natural Pharmaceuticals, Inc. in patent-related matters.

2.

On January 27, 2005, an attorney with Alston & Bird LLP filed the national stage patent application identified above, U.S. Patent Application No. 10/522,696, in the United States Patent and Trademark Office. This application is the United States national stage entry of PCT/US2003/024666, filed August 4, 2003, and claims priority to U.S. Provisional Application No. 60/401,191 filed August 4, 2002.

3.

On April 18, April 20, April 24, and April 26, 2006, I attempted to call Mr. Dasheng Wang at Ohio State University Department of Pharmacology to speak with him about the above-mentioned application and obtain a current address for him to send the complete application and Declaration to him for review and signature. I received no answer to any of the calls (no one picked up).

4.

On April 26, 2006, I also sent, via email to Dasheng Wang's last known email address, a copy of the national stage application as filed, including the specification, claims, abstract, and drawings, a Declaration prepared for signature by Dasheng Wang, a copy of preliminary amendments filed with the national stage application, and a request that Dasheng Wang review the application and sign the Declaration by May 12, 2006. A copy of the email is included as Attachment A. In that email, I also requested a correct address and phone number for Mr. Wang.

5.

On May 1, 2006, I received a response from Mr. Dasheng Wang (Attachment B). In that email, Mr. Wang provided his current mailing address and indicated that he would sign documents "after I receive the patent application and related documents on which Dasheng Wang is the first inventor."

6.

On May 23, 2006, I sent a complete copy of the application as filed, including the specification, claims, abstract, and drawings, a Declaration prepared for signature by Dasheng Wang, a copy of preliminary amendments filed with the national stage application, and a letter requesting that Dasheng Wang review the application and sign the Declaration to Dasheng Wang via Express Mail at the address Dasheng Wang provided in his email dated May 1, 2006. A copy of the letter is included as Attachment C. As mentioned in the letter, I also included a self-addressed, postage-paid United States Postal Service Express Mail envelope for Dasheng Wang to return the signed

documents to me and indicated that the documents may be returned via fax. I requested that the documents be returned by March 28, 2006.

7.

On May 26, 2006, I received an email from Dasheng Wang indicating that he had received the documents sent via Express Mail and that he would not sign the documents. A copy of this email is included as Attachment D.

8.

To date, I have not received a copy of the signed Declaration from Dasheng Wang.

9.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001 and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.



Cynthia V. Hall
Registration No. 56,544

Date: May 30, 2006

PETITION UNDER 37 C.F.R §1.47(a) TO ACCEPT DECLARATION
WITHOUT SIGNATURE OF DASHENG WANG

ATTACHMENT A

Hall, Cynthia

From: Hall, Cynthia
Sent: Wednesday, April 26, 2006 8:26 PM
To: 'wang.941@osu.edu'
Cc: Parker, Thomas
Subject: Patent Applications for Natural Pharmaceuticals

Importance: High

Attachments: WO04013096.pdf; Prel Amndt-v1.pdf; 287534 Declaration with D. Wang-v1.pdf; 287534 Assignment-v1.pdf

Dear Mr. Wang,

I am a patent attorney for Alston & Bird LLP, a law firm that represents your former employer, Natural Pharmaceuticals Inc., in patent matters. It is my understanding from NPI that you are an inventor on the invention in the enclosed U.S. Patent application (and preliminary amendment filed with the U.S. national stage entry) entitled "Methods and Compositions for Converting Taxane Amides to Paclitaxel or Other Taxanes." The U.S. Patent & Trademark Office requires for patent applications a signed statement by all inventors, called a Declaration, a copy of which is also attached. I have also attached a copy of an Assignment of the invention to Natural Pharmaceuticals Inc.

I have been trying to reach you by telephone for some time to mail you a copy of the application and these documents and discuss how to change the order of inventors as listed on this application and corresponding foreign applications. However, I have been unable to reach you by telephone and I do not have a current address for you. It is my understanding that my firm mistakenly listed you as third inventor rather than first inventor on the International patent application for this invention, a mistake which NPI has asked us to correct. Please contact me at the email address or phone number below to provide me with a correct address to send these documents to you and a phone number I can call to discuss making this correction with you or your representatives.

The United States Patent & Trademark Office has sent us a "Notice of Missing Requirements" for the U.S. patent application and set a deadline for us to submit the signed Declaration. Therefore, please review the enclosed patent application and Declaration, complete the relevant parts of the Declaration, and return the Declaration to me (fax is sufficient) by May 12, 2006 so that we may submit it to the United States Patent & Trademark Office. Please also contact me as soon as possible so that we may discuss changing the order of inventorship.

Thank you for your time. Best regards.



WO04013096.pdf
(2 MB)



Prel Amndt-v1.pdf
(192 KB)



287534 Declaration
with D. Wang-v1.pdf



287534
Assignment-v1.pdf (60 KB)

Cynthia V. Hall
Alston & Bird LLP
1201 West Peachtree Street
Atlanta, GA 30309
(404) 881-7764 Direct Dial
(404) 253-8284 Fax
cynthia.hall@alston.com

048767/287534

Tracking:

Recipient

'wang.941@osu.edu'

Parker, Thomas

Delivery

Delivered: 4/26/2006 8:26 PM

Read

Read: 4/27/2006 12:02 AM

PETITION UNDER 37 C.F.R §1.47(a) TO ACCEPT DECLARATION
WITHOUT SIGNATURE OF DASHENG WANG

ATTACHMENT B

Hall, Cynthia

From: DASHENG WANG [wang.941@osu.edu]
Sent: Monday, May 01, 2006 9:27 AM
To: Hall, Cynthia
Subject: Re: Patent Applications for Natural Pharmaceuticals

Dear Ms. Cynthia Hall:

Thank you very much for your e-mail. I'll sign the documents at any time after I receive the patent application and related documents on which Dasheng Wang is the first inventor. Plus, the most important thing is that I need a document signed by both NCI and me, on which state Dasheng Wang is the first inventor of the patents related to this process "Methods and Compositions for Converting Taxane Amides to Paclitaxil or Other Taxanes".

My home address is, 6109 Round Tower Ln, Dublin, OH 43017

Thank you again for making this correction. It's very important to me.

Dasheng Wang, Ph.D.

Principle Investigator, Research Scientist

Div. of Med. Chem. & Pharmacognosy

College of Pharmacy

The Ohio State University

Columbus, Ohio, 43017

Content-Type: multipart/alternative; boundary="----=_NextPart_002_01C66991.2F6369B3" Content-Transfer-Encoding: 7bit -----=_NextPart_002_01C66991.2F6369B3 Content-Type: text/plain; charset=us-ascii Content-Transfer-Encoding: quoted-printable Dear Mr. Wang, I am a patent attorney for Alston & Bird LLP, a law firm that represents = your former employer, Natural Pharmaceuticals Inc., in patent matters. It = is my understanding from NPI that you are an inventor on the invention in = the enclosed U.S. Patent application (and preliminary amendment filed with = the U.S. national stage entry) entitled "Methods and Compositions for = Converting Taxane Amides to Paclitaxel or Other Taxanes." The U.S. Patent= & Trademark Office requires for patent applications a signed statement by all inventors, called a Declaration, a copy of which is also = attached. I have also attached a copy of an Assignment of the invention to= = Natural Pharmaceuticals Inc. I have been trying to reach you by telephone for some time to mail you a = copy of the application and these documents and discuss how to change the = order of inventors as listed on this application and corresponding foreign = applications. However, I have been unable to reach you by telephone and I = do not have a current address for you. It is my understanding that my firm= = mistakenly listed you as third inventor rather than first inventor on the = International patent application for this invention, a mistake which NPI has asked us to correct. Please contact me at the email address = or phone number below to provide me with a correct address to send these = documents to you and a phone number I can call to discuss making this = correction with you or your representatives. The United States Patent & Trademark Office has sent us a "Notice of

5/30/2006

Missin= g= Requirements" for the U.S. patent application and set a deadline for us to= = submit the signed Declaration. Therefore, please review the enclosed paten= t= application and Declaration, complete the relevant parts of the = Declaration, and return the Declaration to me (fax is sufficient) by May 12= ,= 2006 so that we may submit it to the United States Patent & Trademark = Office. Please also contact me as soon as possible so that we may discuss changing the order of inventorship. Thank you for your time. Best regards. <> <<287534 Declaration with D. = Wang-v1.pdf>> <<287534 Assignment-v1.pdf>>=20 Cynthia V. Hall Alston & Bird LLP 1201 West Peachtree Street Atlanta, GA 30309 (404) 881-7764 Direct Dial (404) 253-8284 Fax cynthia.hall@alston.com 048767/287534 *****=20 IRS Circular 230 disclosure:

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 _= _NextPart_002_01C66991.2F6369B3 Content-Type: text/html; charset=us-ascii Content-Transfer-Encoding: quoted-printable

Dear Mr. Wang,

I am a patent attorney for Alston & = Bird LLP, a law firm that represents your former employer, Natural = Pharmaceuticals Inc., in patent matters. It is my understanding from = NPI that you are an inventor on the invention in the enclosed U.S. Patent = application (and preliminary amendment filed with the U.S. national stage = entry) entitled "Methods and = Compositions for Converting Taxane Amides to Paclitaxel or Other = Taxanes." The U.S. Patent & Trademark Office requires = =66or patent applications a signed statement by all inventors, called a = Declaration, a copy of which is also attached. I have also attached a= = copy of an Assignment of the invention to Natural Pharmaceuticals = Inc.

I have been trying to reach you by = telephone for some time to mail you a copy of the application and these = documents and discuss how to change the order of inventors as listed on thi= s= application and corresponding foreign applications. However, I have = been unable to reach you by telephone and I do not have a current address = =66or you. It is my understanding that my firm mistakenly listed you = as third inventor rather than first inventor on the International patent = application for this invention, a mistake which NPI has asked us to = correct. Please contact me at the email address or phone number below= = to provide me with a correct address to send these documents to you and a = phone number I can call to discuss making this correction with you or your = representatives.

The United States Patent & Trademark = Office has sent us a "Notice of Missing Requirements" for the U.S= .= patent application and set a deadline for us to submit the signed = Declaration. Therefore, please review the enclosed patent application= = and Declaration, complete the relevant parts of the Declaration, and return= = the Declaration to me (fax is sufficient) by May 12, 2006 so that we may = submit it to the United States Patent & Trademark Office. Please = also contact me as soon as possible so that we may discuss changing the = order of inventorship.

5/30/2006

Thank you for your time. Best = regards.

= <<WO04013096.pdf>> <<Prel Amndt-v1.pdf>> <<287534 Declaration wit= h= D. Wang-v1.pdf>>
<<287534 Assignment-v1.pdf>>

Cynthia V. Hall
Alston & Bird LLP
1201 West Peachtree Street
Atlanta, GA 30309
(404) 881-7764 Direct Dial
(404) 253-8284 Fax
cynthia.hall@alston.com

048767/287534

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----- _= _NextPart_002_01C66991.2F6369B3--

PETITION UNDER 37 C.F.R §1.47(a) TO ACCEPT DECLARATION
WITHOUT SIGNATURE OF DASHENG WANG

ATTACHMENT C

ALSTON & BIRD LLP

One Atlantic Center
1201 West Peachtree Street
Atlanta, Georgia 30309-3424

404-881-7000
Fax: 404-881-7777
www.alston.com

Cynthia V. Hall

Direct Dial: 404-881-7764

E-mail: cynthia.hall@alston.com

May 23, 2006

VIA EXPRESS MAIL

Mr. Dasheng Wang
6109 Round Tower Lane
Dublin, OH 43017

EV836147804US

Re: U.S. Patent Application for *Method and Compositions For Converting
Taxane Amides To Paclitaxel or Other Taxanes*
U.S. Appl. No. 10/522,696; Filed January 27, 2005
Our File 048767/287534

Dear Mr. Wang:

Thank you for your email dated May 1, 2006. I have enclosed a copy of the above-referenced patent application as filed in the United States Patent & Trademark Office, a Declaration for the referenced patent, and an Assignment of the referenced patent to Natural Pharmaceuticals, Inc. As you will note, the U.S. Patent application is the same as the Patent Cooperation Treaty (PCT) application that mistakenly listed you as third inventor. However, in the United States the order of inventor names on a U.S. patent application is taken from the order in which the names appear on the executed Declaration. See Manual of Patent Examining Procedure (MPEP) 605.04(f). You are listed as first inventor in the enclosed Declaration.

Please review the enclosed patent application and Declaration, sign and date the Declaration where indicated, fax a copy of the executed Declaration to me at (404) 881-7777, and return the original document to me using the self-addressed postage-paid envelope (Express Mail EV 836147804 US) that is enclosed for your convenience. Please note that postage has been paid on the enclosed Express Mail envelope and you may place the sealed envelope in a United States Postal Service mailbox.

In the interest of time, I am sending a copy of the new Declaration before we have received Rex Gallagher's signature. However, John Juchum and James Johnson have signed the revised Declaration naming you as the first inventor. The current deadline for submitting a signed Declaration with the USPTO is May 28, 2006, and we would

Bank of America Plaza
101 South Tryon Street, Suite 4000
Charlotte, NC 28280-4000
704-444-1000
Fax: 704-444-1111

90 Park Avenue
New York, NY 10016
212-210-9400
Fax: 212-210-9444

3201 Beechleaf Court, Suite 600
Raleigh, NC 27604-1062
919-862-2200
Fax: 919-862-2260

601 Pennsylvania Avenue, N.W.
North Building, 10th Floor
Washington, DC 20004-2601
202-756-3300
Fax: 202-756-3333

Mr. Dasheng Wang
May 23, 2006
Page 2

appreciate receiving the Declaration before that date. If for some reason you cannot execute the documents before that date, please contact me.

Please note that the Declaration and Power of Attorney does not require a notary or witness signature. Please also review and execute the enclosed Assignment, which is required to be filed in the corresponding Canadian patent application. Though we generally prefer to receive notarized signatures on Assignments, if this is a problem please send it to us with a witness signature instead of a notary certification.

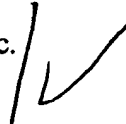
If you have any questions about the patent application or these documents, please call me at the telephone number listed above. Please also contact me so that we may discuss what we are doing to attempt to change the order of inventorship in the pending patent applications in other countries. Thank you for your assistance.

Very truly yours,



Cynthia V. Hall

cc: James M. Johnson, Natural Pharmaceuticals, Inc.
Thomas J. Parker, Alston & Bird LLP



Enclosures

ATL01/12212006v1

PETITION UNDER 37 C.F.R §1.47(a) TO ACCEPT DECLARATION
WITHOUT SIGNATURE OF DASHENG WANG

ATTACHMENT D

Hall, Cynthia

From: DASHENG WANG [wang.941@osu.edu]
Sent: Friday, May 26, 2006 9:38 AM
To: Hall, Cynthia
Cc: franke_roland@alum.mit.edu; chowe@alum.mit.edu; dsw1688@yahoo.com
Subject: WO patent

Dear Ms. Cynthia Hall:

I received the documents last night. But, unfortunately, I can not sign the documents as you asked. As I mentioned on the e-mail which I sent to you on May 1, I'd like to sign the documents when I get the revised version of WO patent on which the order of inventorship is as same as on the Declaration document. It is Patent instead of Declaration will be published. Plus, evrybody knows that the the order of inventorship on the Patent shouldn't conflict with the Declaration. I think that you know that better than I do. Thanks a lot.

Dasheng Wang, Ph.D.

Principle Investigator, Reseach Scientist

Division of Medicinal Chemistry and Pharmacogonosy

College of Pharmacy

The Ohio State University

5/30/2006